

REMARKS

This is in response to the Office Action of January 9, 2009. In the claim set, numbering corrections are made to claims 22-26. New claim 27 is added, directed to a water-based silylated urethane composition. No new matter is introduced by this Amendment. Claims 1-7, 9-13, and 15-27 are now pending in the application.

NO RESTRICTION – NO ELECTION. The Office Action alleges that the Amendment filed September 30, 2008 “set forth only claims drawn to a non-elected invention.” This is manifestly erroneous. There has been no restriction requirement in the present application, and there has been no election in response to that non-existent restriction requirement.

Claims 1-7 and 9-13 are limited to a method of wrapping of using the compositions originally claimed. Claims 15-26 are limited to a method of contact adhesion using those compositions. The invention of current claims 1-7, 9-13, and 15-26 is therefore dominated by the scope of the invention originally covered by such claims. New composition claim 27 likewise falls within the scope of the original claims. FURTHER ACTION ON THE MERITS OF ALL OF CLAIMS 1-7, 9-13, AND 15-27 IS RESPECTFULLY SOLICITED.

Applicants rely upon their Amendment filed September 30, 2008 for their response to the rejections of record. With respect to new claim 27, the following additional observations are made.

Claim 9 (upon which new claim 27 is based) was rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 93/23490 in view of Frisch and Yu and Stuart. Office Action of June 19, 2008, page 5. The rejection is traversed. The rejection picks and chooses features from four different references to reject this single claim. The recent decision of the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (U.S. 2007) supports Applicants’ position in this regard. The holding of the Court makes it clear that simply showing that all of the elements of the application/patent claim are present in the prior art does not necessarily mean that an invention is obvious. The Court states that “... a patent composed of

several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art" and that "This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." The question under 35 U.S.C. § 103(a) is not whether the differences between the prior art and the invention in and of themselves would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983). The Supreme Court has held that "... a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art."

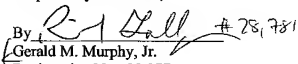
Contact information

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: January 29, 2009

Respectfully submitted,

By  # 28,781
Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant